



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,088	08/24/1999	ERNEST G. HOPE	A-67031-I/RF	4793

7590 10/02/2002
ANITA L. MEIKLEJOHN, PH.D.
FISH & RICHARDSON P.C.
225 FRANKLIN STREET
BOSTON, MA 02110-2804

EXAMINER

DECLOUX, AMY M

ART UNIT PAPER NUMBER

1644

DATE MAILED: 10/02/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/382,088

Applicant(s)

Hope et al.

Examiner

DeCloux, Amy

Art Unit

1644

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6-26-02, 1-25-02 and 2-19-02
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.
- ## Disposition of Claims
- 4) ☒ Claim(s) 15-59 is/are pending in the application
- 4a) Of the above, claim(s) 15-42 is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43-50 and 52-59 is/are rejected.
- 7) ☒ Claim(s) 51 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Aug 24, 1999 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendments filed 6-26-02(paper No. 21), 1-25-02 (Paper No.19), and 2-19-02 (Paper No.18) are acknowledged and have been entered.
2. Claims 1-15 have been canceled and claims 43-59 have been newly added. In view of Applicant's amendment the outstanding rejections have been withdrawn. However, a new grounds of rejection follows.
3. Formal drawings and/or photographs have been submitted which fail to comply with 37 CFR 1.84. Please see the form PTO-948 enclosed with the action mailed 7-17-01 (Paper No.16).

As of May 3, 2001, examiners may not permit corrections to drawings to be held in abeyance. Applicant must submit proposed drawing corrections in response to the instant office action.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

A). Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability."

Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

B) Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, MUST be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings MUST be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

4. A) Applicant should amend the first line of the specification to update the status (and relationship) of the priority documents. The first sentence of the specification should refer to the provisional application using language such as:

This application claims the benefit of U.S. Provisional Application No. 60/097,640, filed 8/24/98. See MPEP 1302.04.

B) The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 43-50 and 52-59 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for reducing immune mediated damage to cells, tissues or organs comprising contacting a cell, tissue or organ with an immunoprotective amount of HSP47 (SEQ ID NO:6) or a fragment thereof that consists of AVLSAEQLR (SEQ ID NO:3), or a fragment thereof wherein said immune mediated damage is caused by CIK cells, does not reasonably provide enablement for the broader recitation of reducing any immune mediated damage to a cell, tissue or organ. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The specification disclosure is insufficient to enable one skilled in the art to practice the invention as broadly claimed in the instant claims without an undue amount of experimentation. The scope of the claims is not commensurate with the enablement provided by the disclosure with regard to the large number of immune mediators capable of immune mediated damage to cells broadly encompassed by the claims.

The instant specification provides enablement only for a method comprising the HSP47 polypeptide (SEQ ID NO:6), and a fragment of an HSP47 polypeptide consisting of the sequence AVLSAEQLR (SEQ ID NO:3), and compositions thereof, in reducing immune-mediated damage by CIK cells. The instant specification does not provide sufficient direction that said HSP47 peptides protect against immune-mediated damage by other immune cell. Linn et al (British Journal of Hematology 2002, 116:78-

86) teach that CIK cells are a novel population of immune effectors distinct from other immune effector cells such as NK cells, CTLs or LAKs, by virtue of their unique phenotype of their CD3+ CD56+ phenotype, (see entire article, especially page 78, column 1). However the literature is silent with respect to the ability of HSP47 peptides to reduce immune mediated damage by cells other than CIK. In view of the diversity of immune effector cells, it would require undue experimentation for one of skill to predict which immune effector cells, other than CIK cells, would be effected by the recited HSP47 peptides without further guidance and direction from the instant specification. In re Fisher, 166 USPQ 18 indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute.

7. Claim 51 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy DeCloux whose telephone number is (703) 306-5821. The examiner can normally be reached Monday through Friday from 9:00 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Serial No. 09/382,088
Art Unit 1644

-5-

Amy DeCloux, Ph.D.
Patent Examiner,
September 26, 2002

Pat J. Nolan

Patrick J. Nolan, Ph.D.,
Primary Patent Examiner,
Group 1640